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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,650	12/30/2003	Lee Delson Wilhelm	19,927	6898
23556	7590	12/31/2007	EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC. Catherine E. Wolf 401 NORTH LAKE STREET NEENAH, WI 54956			AFZALI, SARANG	
		ART UNIT	PAPER NUMBER	
		3726		
		MAIL DATE	DELIVERY MODE	
		12/31/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/748,650	WILHELM, LEE DELSON	
	Examiner	Art Unit	
	Sarang Afzali	3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Amendment filed 10/8/2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 and 20 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 and 20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 5/25/2007 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

Response to Amendment

1. The applicant's amendment filed on 10/8/2007 has been fully considered and made of record.
2. Claims 17-19 are cancelled.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-16 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In both independent claims 1 & 2, the newly added limitation "a length of about 0.06 inch or greater" is very confusing and not clear as if it is referring to the embossing element height/depth or something else? Note that the disclosure (specification, page 6, lines 3-7 and drawings including Figs. 1 & 3) refers to an embossing element having an element height 20, or engraving depth, as the distance between a top 22 and a base 24. Considering that both claims 1 & 2 explicitly recite an "embossing element having a length of about 0.06" and "a top comprising a flat surface having a width", it appears that this length can not be part of the top surface.

Furthermore, the disclosure (specification, the paragraph bridging pages 6 and 7) refer to a top surface of the embossing element with a width 33 and a length 31 that

refers to the length (depth into the page in Fig. 1) of the embossing element at the top. The Examiner considers this length 31 (not shown in Fig. 1) to be the "length" of each side wall in the newly added limitation of "first sidewall having a **length** perpendicular to the width of the top surface . . . second sidewall having a **length** perpendicular to the width of the top surface" as recited in claims 1 & 2.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-14 and 20, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Boegli (US 2004/0109911).

As applied to claims 1 and 2, Boegli teaches an apparatus (1, Fig. 1) comprising: a surface containing at least one elongated curvilinear embossing element (a first embossing roll 2, Fig. 1) having a top comprising a flat surface having a width (truncated pyramid tooth profiles 8 with flat top surface, Fig. 3B); the embossing element having a first sidewall with a first angle and an opposite second sidewall with a second angle wherein each of the first and second sidewalls has a length perpendicular to the width of the top surface (Fig. 3b). Note that Boegli teaches (paragraph [0038]) that there are two embossing rolls 2 in the apparatus 1, therefore meeting the claim 2 limitations of a pair of first sidewalls and a pair of second sidewalls.

Boegli further teaches (paragraph [0035]) that:

"The production of inscriptions, devices, and the like, hereinafter called patterns, is realized by removing or shortening teeth on the embossing roll 2 that comprises teeth 8. The rings resp. longitudinal ribs may influence the appearance of the embossed patterns produced by means of the embossing roll provided with the teeth. Through variations of the teeth 8 or of rings 10 or longitudinal ribs 12, i.e. by modifications of the height, of the flanks or the edges of the teeth, the rings, or the longitudinal ribs, or through patterns provided on the upper surface thereof, the embossing roll combinations of the invention allow to produce embossed patterns or signs generating a particular optical effect such that the embossed pattern changes as it is viewed from different angles and/or under different lighting conditions or only appears under a certain angle and/or under certain lighting conditions. To this effect, the height of the teeth, of the rings or of the longitudinal ribs may be varied, or the design of individual teeth, of entire rings or of parts thereof, and of entire ribs or of parts thereof may differ from that of the remaining elements."

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have provided Boegli with the claimed length of "0.06 inch" and first and second opposing sidewall angles with different values, in order to provide a desired embossed appearance and effect.

Boegli teaches that the tooth profile can be modified into a variety of configuration resulting in any desired embossed patterns that would be viewed differently under certain conditions. The Applicant's objective is to improve the appearance or embossing definition produced in the substrate by the embossing process (specification, page 1, lines 30-31). As such Boegli teaches that the viewing of the embossed patterns under certain conditions (lighting and angle) can be improved.

As applied to claim 3, Boegli teaches that the embossing surface comprises a male (truncated profiles 8, Fig. 3B) embossing element.

As applied to claims 4-7, 9, 10, 12, 13, 15, 16 and 20, Boegli teaches the claimed invention with the exception of explicitly teaching the specific claimed sidewall angles, gap dimensions and top radius.

Boegli teaches that the tooth profile can be modified into a variety of configuration (meaning different sidewall angles and gap dimensions and radii) resulting in any desired embossed patterns. Therefore, it would have been an obvious matter of design choice to a person of ordinary skill in the art, at the time of the invention, to have provided Boegli with the claimed sidewall angles, gap dimensions and top radii, in order to provide a patterned surface having the desired characteristics.

7. Claims 8, 11 and 14 are, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Boegli (US 2004/0109911) in view of Makoui et al. (US 2002/0007749).

Boegli teaches the claimed invention but does not explicitly teach the claimed metal roll.

However, it is well known in the art to use metal alloys in an embossing roll. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have provided the embossing surface of the Boegli's element with a suitable metal alloy as taught by Makoui et al. in order to provide a desired embossed pattern on an article.

Response to Arguments

8. Applicant's arguments with respect to claims 1-16 and 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarang Afzali whose telephone number is 571-272-8412. The examiner can normally be reached on 7:00-3:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


SA
12/21/2007


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SUPERVISORY PATENT EXAMINER

